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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,242

Applicant(s)

ST.JOHN, CALI

Examiner

Jessica L. Rossi

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment, 5/28/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: copy of claims 10/360,488.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 5/28/04. Claims 1-20 are pending but claim 20 is withdrawn from further consideration.
2. Applicant's election of Group I, claims 1-19, in the reply filed on 5/28/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. The rejection of claims 1-3, 5-6, 9-10, 12, and 16 under 35 U.S.C. 103(a) as being unpatentable over Kagami (JP 6-171650; of record) in view of Bozlee (US 6354645; of record), as set forth in paragraph 8 of the previous office action has been withdrawn in light of the added limitations pertaining to the protective the protective member manufacturer conveying by profit making sale a right to attach indicia to the protective members (note Kagami teaches the protective member manufacturer selling the members to the can filler who then sells the right to attach indicia thereon to a third party advertiser; section [0012] of written translation; therefore, the reference fails to teach or suggest the protective member manufacturer selling the right to advertise to the third party).

Claim Objections

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4. Claims 2-3 are objected to because of the following informalities: --party advertisers-- should be inserted after "third" in line 4 of claim 2; "a beverage container" should be --the beverage container-- in lines 11-12. Appropriate correction is required.

Art Unit: 1733

5. Lines 14-17 of claim 3 fail to further limit claim 1 since these limitations were already set forth in claim 1. It is suggested to cancel these limitations in claim 3.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 2, the present specification does not have support for the third party advertiser not being a container filler. It is noted the specification defines "third party" as neither the supplier of the invention nor the beverage seller on which the invention is employed (p. 5, 2nd paragraph); however, a beverage seller does not necessarily have to be the container filler.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claims 1-2, 4-5, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. (US 3690509; of record) in view of Bozlee (US 6354645; of record).

With respect to claim 1, Kinoian is directed to a method for a protective member manufacturer relating to beverage containers. The reference teaches manufacturing consumer removed, flexible protective member 10 (Figure 1; column 2, lines 43-50), applying advertising

Art Unit: 1733

indicia 23 to the protective member (Figure 1; column 3, lines 27-30), and adhering the protective member to the container 11 to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of the mouth contact area of the container (Figure 1; column 3, lines 10-25; column 4, lines 24-25).

The reference is silent as to the protective member manufacturer conveying by profit making sale to third party advertisers a right to attach indicia to the protective member.

It is known to engage in a method of doing business where the manufacturer of a flexible member (bag handle) sells the right to a third party advertiser (i.e. pizza company) to advertise on the bag handles, as taught by Bozlee (Figure 2; column 3, lines 1-5 and 22-26 and 36-38). The handle maker then gives the handles to a grocery store to attach to their grocery bags (column 3, lines 35-38). The advertising revenue generated allows the handle manufacturer to penetrate the market by giving the handles away freely to grocery stores (column 3, lines 36-38). The skilled artisan would have readily appreciated that this revenue would have to be in the form of profit; otherwise, the handle manufacturer would not be able to give away his product without business going under.

Therefore, it would have been obvious to the skilled artisan at the time the invention was made to have the protective member manufacturer convey by profit making sale to third party advertisers a right to attach the advertising indicia taught by Kinoian to the protective members of Kinoian because such is a known business method, as taught by Bozlee, and it creates a business for a fourth party (protective member manufacturer being neither the advertiser, can filler, nor consumer).

Art Unit: 1733

Regarding claim 2, Bozlee teaches the third party advertiser, or pizza company, being neither the bag distributor (= can filler) nor the handle manufacturer (= protective member manufacturer).

Regarding claim 4, Kinoian teaches sanitizing at least a portion of the can (column 3, lines 40-45).

Regarding claim 5, Kinoian teaches the indicia being advertising or instructions (column 3, lines 29-30).

Regarding claim 12, Kinoian teaches adhering the members using adhesive (column 3, lines 10-20).

10. Claims 3, 6, 9-10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. and Bozlee as applied to claim 1 above, and further in view of Kagami (JP 6-171650; of record).

Regarding claim 3, Kinoian teaches the protective member not being limited to a particular configuration wherein the configuration facilitates adherence to a top and convex side of a can without deformation and without wrinkling of the member by folding it over a rim of the container when adherence occurs (Figures 1 and 3-6). However, the reference is silent as to an hourglass configuration.

It would have been obvious to the skilled artisan at the time the invention was made to use an hourglass configuration for the protective member of Kinoian because it is known to adhere an hourglass-shaped protective member to a top and convex side of a beverage can, as taught by Kagami (Figures 3-4; section [0010] written translation), wherein such a configuration conforms to the contours of the can well. Note similarities between shape of protective member

Art Unit: 1733

of Kagami and protective member of present invention as shown in Figure 4. Therefore, the skilled artisan would have appreciated that the hourglass configuration of the protective member of Kagami would facilitate this adherence without deformation or wrinkling.

Regarding claim 6, Kinoian is silent as to applying the indicia by printing. It would have been obvious to the skilled artisan to apply the indicia by printing because such is known in the art, as taught by Kagami (section [0007] of written translation), wherein such a technique works well with plastic.

Regarding claims 9-10, Kagami teaches applying the printed indicia to an underside of an opaque protective member ([0007] of written translation). It would have been obvious to have the protective member of Kinoian be opaque with indicia applied to the underside thereof because such is known in the art, as taught by Kagami, thereby peeking the curiosity of the consumer who cannot read the indicia until they have been purchased the container and removed the protective member.

With respect to claim 16, all the limitations were addressed above with respect to claim 3.

11. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al., Bozlee, and Kagami as applied to claim 6 above, and further in view of Burns (US 6127437; of record).

Regarding claims 7-8, Kinoian is silent as to treating the protective members using corona discharge so that the same accepts and retains printing ink. It is known to treat a plastic closure for a liquid container using corona discharge so that the closure accepts and retains printed matter, as taught by Burns (Figure 1; column 2, lines 51-56; column 5, lines 46-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 1733

treat the plastic protective member of Kinoian using corona discharge so that the member accepts and retains printed matter because such is known, as taught by Burns, and this ensures that the desired indicia successfully appears on the member.

12. Claims 11, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al., Bozlee, and Kagami as applied to claim 10 above, and further in view of Ruemer (US 4402421; of record).

Regarding claim 11, Kinoian is silent as to the indicia being used for such things as those recited in the present claim.

It is known in the art to cover the top of a beverage container with a protective member bearing indicia used for such things as redeemable prizes, as taught by Ruemer (Figure 4; column 2, lines 23-25 and 49-51). One reading Kinoian as a whole would have appreciated that the reference is not limited to any particular type of advertising and therefore it would have been obvious to the skilled artisan at the time the invention was made to have the indicia printed on the underside of the members of Kagami be used for such things as redeemable prizes without the user knowing in advance of protective member removal which of a plurality of chances the user has obtained because such is known in the art, as taught by Ruemer, wherein such things peek the curiosity of consumers thereby increasing sales.

Regarding claim 17, all the limitations were addressed above with respect to claim 11.

Regarding claim 19, Kinoian teaches the protective members can be completely removed from the containers and therefore the examiner would have appreciated that the members of Kinoian would be capable of being completely removed from the containers and collected by a consumer if he/she chose to do so (perhaps he/she collects advertisements for a hobby).

Art Unit: 1733

13. Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. and Bozlee as applied to claim 12 above, and further in view of Takayama (US 6015059; of record).

Regarding claim 13, Kinoian is silent as to the adhesive being antibacterial. It would have been obvious to the skilled artisan at the time the invention was made to use an antibacterial adhesive for the adhesive of Kinoian because such is known in the art, as taught by Takayama (column 3, lines 26-31), wherein this prevents any bacterial growth from forming in the areas having adhesive thereon.

Regarding claim 18, it would have been obvious to the skilled artisan at the time the invention was made to use an adhesive that allows for reattachment of the portion of the member that was removed to expose the pour spout because such is known in the art, as taught by Takayama (column 3, lines 1-7), wherein this prevents contamination of the contents within the can while also allowing for storage of an unfinished beverage until a later time.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. and Bozlee as applied to claim 1 above, and further in view of Dronzek (US 5925208; of record) and Sommers (US 6620281; of record).

Regarding claim 14, Kinoian is silent as to imposing anti-static chemical treatment on the protective members.

It is known to impose anti-static chemical treatment to adhesively backed labels having indicia printed thereon (note protective members similar to adhesively backed labels), as taught by Dronzek (column 8, lines 30-35 and 65-68). Therefore, it would have been obvious to the skilled artisan at the time the invention was made to impose anti-static chemical treatment to the

label-like protective members of Kinoian because such is known, as taught by Dronzek, wherein this would produce the expected results of preventing unwanted sticking/clinging. The skilled artisan would have appreciated that like the anti-static chemically treated members of the present invention, the anti-static chemically treated members of Kinoian would also slide easily from an adjoining member and not cling to it under high speed dispensing.

The examiner would like to point out that the present claim language is not positively claiming a method step of high speed dispensing of adjoining protective members. However, to expedite prosecution, the examiner would like to point out that it is known in the art to apply an adhesively-backed label to a beverage can using a cut and stack method that involves high speed dispensing of labels placed on top of each other in a stack, as taught by Sommers (Figure 5; column 3, lines 22-25; column 4, lines 16-28). Therefore, it would have been obvious to the skilled artisan at the time the invention was made to apply the label-like protective members of Kinoian using a cut and stack method because such is known in the art, as taught by Sommers, wherein this method allows for high speed application of the members (Sommers; column 4, lines 25-28).

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoian et al. and Bozlee as applied to claim 1 above, and further in view of Miyazaki et al. (US 5863624; of record).

Regarding claim 15, the adhesive 22 of Kinoian forms a stronger bond with the protective member than with the can such that no adhesive residue is left on the can after removal of the member (column 3, lines 19-24). Kinoian ensures this by using an adhesive which bonds more strongly to the member and less strongly to the can (column 3, lines 19-24).

It is known in the label art to increase bonding strength between an adhesive and a plastic layer (note the protective member of Kinoian is a flexible, plastic layer with indicia thereon - just like a label) by imposing treatment to the surface of the plastic layer before applying the adhesive thereto, as taught by Miyazaki (column 1, line 21; column 2, lines 64-68; column 5, lines 17-20; column 6, lines 15-18).

Therefore, it would have been obvious to the skilled artisan at the time the invention was made to ensure a stronger bond between the adhesive and protective member of Kinoian than that which exists between the adhesive and can by treating the protective member because such is known in the art, as taught by Miyazaki, wherein this serves as an alternative to using a particular adhesive that bonds more strongly to the members, thereby increasing the types of adhesives that can be used. As for a particular type of treatment, such would have been within purview of the skilled artisan at the time the invention was made absent any unexpected results; it being noted that chemical treatment (i.e. use of primers) is well-known and conventional.

Double Patenting

16. Claims 16 and 17 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 3 and 11, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 1733

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 1-2, 4-8, 12-16, and 18-19 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 10-13, 15-16, and 19 of copending Application No. 10/360,488. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '488 application encompass the limitations of the present claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claim 3 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 of copending Application No. 10/360,488 in view of Kagami.

With respect to claim 3, all the limitations were addressed above with respect to claim 1, except the member being in an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation and without wrinkling of a material of the protective member by folding it over a rim of a beverage container when adherence occurs.

Claim 3 of the copending application teaches all these limitations except folding the member over the rim of the container when adherence occurs. It would have been obvious to do

so because such is known in the art, as taught by Kagami, and allows for a good fit between the can top and member.

This is a provisional obviousness-type double patenting rejection.

20. Claims 9-10 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/360,488 in view of Kagami.

Regarding claims 9-10, the copending application is silent as to these limitations. It would have been obvious to use an opaque protective member having printing on the underside thereof because such is known in the art, as taught by Kagami in paragraph 8 above, wherein this peeks the curiosity of the consumer thereby increasing sales.

This is a provisional obviousness-type double patenting rejection.

21. Claims 11 and 17 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/360,488 in view of Ruemer.

Regarding claim 11, it would have been obvious to the skilled artisan at the time the invention was made to have the underside printing on the opaque member of Kagami relate to such things recited by the copending application because such is known in the art, as taught by Ruemer, wherein this peeks the curiosity of the consumer thereby increasing sales.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

22. Applicant's arguments filed 5/28/04 have been fully considered but they are not persuasive.

Art Unit: 1733

23. On pages 1-2 of the arguments, Applicant argues that Bozlee is directed to placing handle around a shopping bag, wherein the handle is not in any manner a protective member.

Therefore, Applicant argues that Bozlee is non-analogous art. Applicant further argues that one skilled in the art would not be motivated to take the indicia properties of Bozlee and apply that sale of information to the sale of information on a consumer removed flexible protective member adhered to beverage containers.

The examiner points out that Bozlee was only used to show it being known in the business method art to attach a flexible member to an object wherein the flexible member displays indicia in the form of advertising, which belongs to a third party who purchased the rights to display this advertising from the manufacturer of the flexible member. To rephrase, Bozlee was only relied upon for its teaching of a particular business method (selling advertising rights to a third party who is neither the flexible member supplier nor the supplier of the object to which the flexible member is attached) and not for the particular type of flexible member upon which the advertising is being placed.

Furthermore, the primary reference to Kinoian teaches advertising can be placed on the flexible protective member adhered to the beverage container, wherein the skilled artisan would have been motivated to look to business method teachings relating to the sale of advertising rights, such as that of Bozlee, especially since Bozlee, like Kinoian, teaches this advertising being placed on a flexible member which is then attached to another object.

24. On pages 2-4, Applicants arguments pertain to the Kagami reference.

The examiner points out that Kagami is no longer being used as a primary reference for the reasons set forth in paragraph 3 above. In the present office action, Kagami was only used to

Art Unit: 1733

show it being known in the art to make flexible protective members in the shape of an hourglass and adhere these members to a beverage container wherein advertising is printed onto the underside of an opaque protective member.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine R. Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica L. Rossi
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